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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,128	02/27/2006	Murray Goodman	041673-3108	1953
30542 7590 08/12/2009 FOLEY & LARDNER LLP P.O. BOX 80278 SAN DIEGO, CA 92138-0278				
EXAMINER				
SILVERMAN, ERIC E				
ART UNIT		PAPER NUMBER		
1618				
MAIL DATE		DELIVERY MODE		
08/12/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/522,128

Applicant(s)

GOODMAN ET AL.

Examiner

ERIC E. SILVERMAN

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-57 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF 298)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claims 1-57 are currently pending in the instant application.

Priority

This application is a 371 of PCT/US03/22771, filed 07/18/2003, which claims priority to U.S. Provisional patent application 60397319 filed on 7/19/2002.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

Lack of Unity Requirement

Claims 1-57 are drawn to more than one inventive concept (as defined by PCT Rule 13), and accordingly, a restriction is required according to the provision of PCT Rule 13.2.

PCT Rule 13.2 states that the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (requirement of unity of invention).

PCT Rule 13.2 states unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

Annex B, Part 1 (b), provides that "special technical features" mean those technical features, which, as a whole, define a contribution over the prior art.

Annex B, Part 1 (e), provides combinations of different categories of claims and states:

"The method for determining unity of invention under Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(i) in addition to an independent claim for a given product, an independent claims for a process specially adapted for the manufacture of the said product, and an independent claim for use of the said product, or

(ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specially designed for carrying out the said process, or

(iii) in addition to an independent claim for a given product, and independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for an apparatus or means specially designed for carrying out the said process,..."

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I: Claims 1-30, drawn to a transport molecule and formulation including the same.

Group II: Claim 31, drawn to a method of increasing the effectiveness of a drug.

Group III: Claims 32-35, drawn to a method of increasing transport of a bioactive.

Group IV: Claims 36-56, drawn to a dendrimer optionally having a fluorescein molecule bound thereto.

Group V: Claim 57, drawn to a method of synthesizing a dendrimer.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or

corresponding special technical features for the following reasons: they do not share the same structural element(s) that define the “special technical feature” necessary to specify a contribution over the prior art.

The structural moiety, element, or step common to **Groups I-V** is a dendrimer with the groups mentioned in claim 1, which is known in the art (see US 6,720,355, figure 1, having protected groups of the type required by claim 1) and therefore, cannot be said to be the special technical feature that makes a contribution over the prior art. All other structural moieties, elements, or steps differ materially from one another. Thus, these claims lack the corresponding special technical feature(s) necessary to link them together to fulfill the Unity of Invention requirement.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

In addition, applicant is further required to elect a single species for each of genus, as outlined below. A species must be elected for each genus irrespective of which Group is elected.

(1) Different dendrimers. Applicants must elect a single dendrimer. The election must specify the nature of each dendron and of the core molecule, with no alternative or undefined groups. This requirement may be satisfied, for example, be electing a dendrimer with the structure of claim 19. **(2) Different molecules bonded to the dendrimer.** Applicants must elect the molecule bonded to the dendrimer. The molecule must be elected by chemical name or formula, with no undefined or alternative groups. As part of this requirement, Applicants must indicate the linkage

between the molecule bound to the dendrimer and the dendrimer itself. For example, if the molecule bound to the dendrimer is an carboxylic acid, and the dendrimer has terminal amines, Applicants satisfy this portion of the requirement by indicating that the carboxylic acid is bound to the terminal amine by an amide linkage. To the extent that some embodiments of some of the claims do not require a molecule bonded to the dendrimer, Applicants may satisfy this requirement by electing that no molecule is bound to the dendrimer.

Because this requirement is complex, a telephonic reply was not solicited.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). A complete response will also include an election of species consonant with the requirement set forth herein, and a listing of claims readable on the elected species. Applicant is reminded that should any new claim(s) be added at a later time, Applicant is obliged to determine whether or not the newly added claim(s) read on the elected species and to make a statement to this effect at the time that the claim(s) are added.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double

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patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC E. SILVERMAN whose telephone number is (571)272-5549. The examiner can normally be reached on Monday to Thursday 7:00 am to 5:00 pm and Friday 7:00 am to noon.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571 272 0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric E Silverman/

Primary Examiner, Art Unit 1618